



Trademarks

*Powerful tools to protect your brand and
prevent fraud/unfair competition*

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What is a Trademark?

- Trademarks are symbols, characters, and words that **distinguish** products or services from those of others
- A trademark is used in connection with a product - ® or TM
- A service mark is used in connection with a service- ® or SM

The logo for Milliken, featuring the word "Milliken" in a blue, cursive script font. A small "TM" trademark symbol is located at the bottom right of the word.The logo for Lyft, featuring the word "lyft" in a bold, pink, sans-serif font. The letters are stylized, with the "l" and "y" being particularly prominent.

Trademarks

- Limited to classes of goods or services
- Limited in geographic territory (each country has own system)
- Trademark owner can stop others from using a mark in a manner likely to cause confusion
- Use as adjective (source identifier)



CAPTURE

Strength of Marks

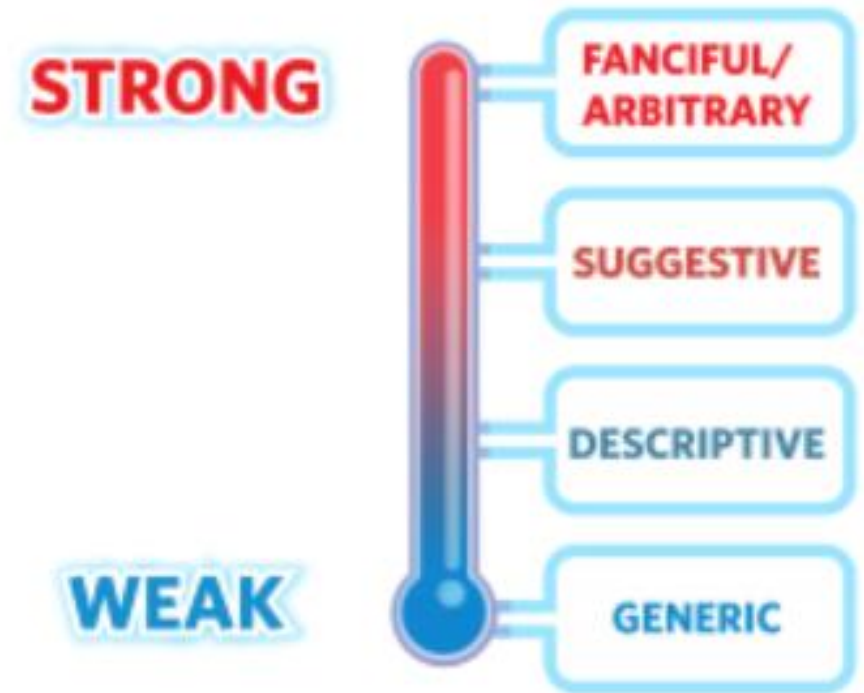
Arbitrary – made up words: Google, Rolex; Xerox (strong marks but harder to connect with the goods/services)

Fanciful – real words but not descriptive of goods/services: DOVE soap; APPLE computers

Suggestive – real words, i.e., ROMAN MEAL bread requiring a leap of logic to connect with the goods.

Descriptive – describes good or service (a “not-a-mark” mark without “secondary meaning” acquired through use and acceptance by the public)

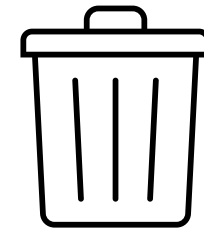
Generic – the name of the thing; (a “not-a-mark” mark)



<https://www.uspto.gov/trademarks/basics/strong-trademarks>

Additional Things to Consider

- Translations
- Abbreviations
- Cultural interpretations
- Brand strategy- house mark/sub-brand



Trademarks in the US

Federal and State Law

- Trademark rights in the U.S. are **based on use in commerce**.
 - A trademark must be used in commerce before registration is granted
- Two Registration Systems in the U.S.
 - Federal Trademark Registration- covers all 50 states with presumptive rights
 - State Trademark Registration- applies to specific state or portion thereof- Doesn't provide ability to use ® symbol

Common Law Rights

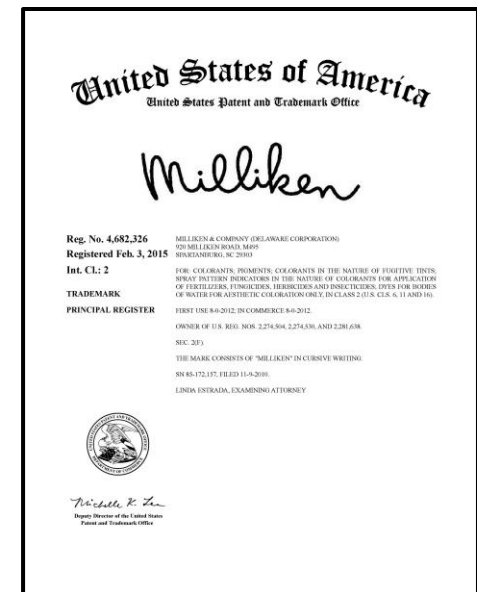
U.S. and some other countries

- First to file doesn't guarantee senior rights
- Under common law- a user acquires common law rights in particular jurisdictions the date a mark was first used in the U.S. for a particular good or service, even without registration
- Such use can establish a right of priority (or "carve out") over a later-filed US application



Benefits of Federal Registration

- Gives presumptive use throughout the U.S.
- Makes the mark easy to find/discourage others from adopting similar marks
- Protects against others registering similar marks
- Enables owner to use ® symbol with its mark for the associated goods/services
- Right to sue in federal court; certain advantages in litigation
- Can use as basis for filing outside of the U.S.
- U.S. Customs can block imports of infringing goods



Trademark Registration

Process and types of marks



Standard Character Mark(s)

- Also known as a word mark (e.g. NIKE)
- Protects the wording no matter how the words are displayed

Special Form Mark(s) (stylized)

- Used to protect font, color, or size of mark



Identification of Goods/Services

Requires specificity

Identification of goods and services must be specific

- For many goods and services, U.S. law requires the nature of the field of use.

Examples:

- “Software” is unacceptable
- “Anti-spyware software” is acceptable
- “Kitchen utensils” is unacceptable
- “Kitchen utensils, namely serving scoops, spatulas, and graters” are acceptable



Trademark Registration Process



- Can file based on Use
or
- Can file as Intent-to-Use if have bona-fide intention to use*
- PTO Examines, once ready to allow, will publish for opposition (30 days/extendable)

*Note- with ITU, must prove use prior to registration

Specimens (proof) of Use

Specimen of Use – Goods

- A mark shall be deemed to be in use when
 - it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale (first use anywhere), and
 - the goods are sold or transported in commerce (first use in commerce).
- Must be bona fide use of a mark in the ordinary course of trade; "token use," or use made solely to reserve rights in a mark is not acceptable (in reality, may be accepted during prosecution, but could make registration vulnerable if contested in the future)

Specimens of Use

Specimen of Use – Services

- A mark shall be deemed to be in use when it is used or displayed in the sale or advertising of services (first use anywhere) and the services are rendered in commerce (first use in commerce).
- The mere announcement of a future service is not evidence of use as a service mark: must already have rendered the service prior to filing a use-based application.
- Traditional examples – business cards, brochures, invoices, advertisements. Now applicants often use “Services” page of a website.



What could possibly go wrong?

 MAYNARDNEXSEN

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Prior to Filing

Conduct a TM Clearance Search

Two Types of Common TM Searches

- Knock-out – inexpensive (<10 references)
- Complete – exhaustive, expensive, State and Federal

Searches are economical and forward-thinking, helps establish a strategy, and allows applicant time to test different brandings.



Police Your Marks



XEROX

There are two R's in Xerox.

“Dead” Marks – Failure to Police

- Escalator
- Trampoline
- Cube steak
- High octane
- Raisin bran
- Cornflakes
- Shredded wheat
- Dry ice
- Lanolin
- Linoleum
- Mimeograph
- Yoyo
- Kerosene



Infringement Examples

- **MILLAD 3988® chemicals**

- vs.

- **MILLARD 3988 chemicals**

Infringement Examples

Customs contacted Milliken when discovered comforters coming in from China with Crafted with Pride in U.S.A. trademark (with bent star)



COMFORTERS



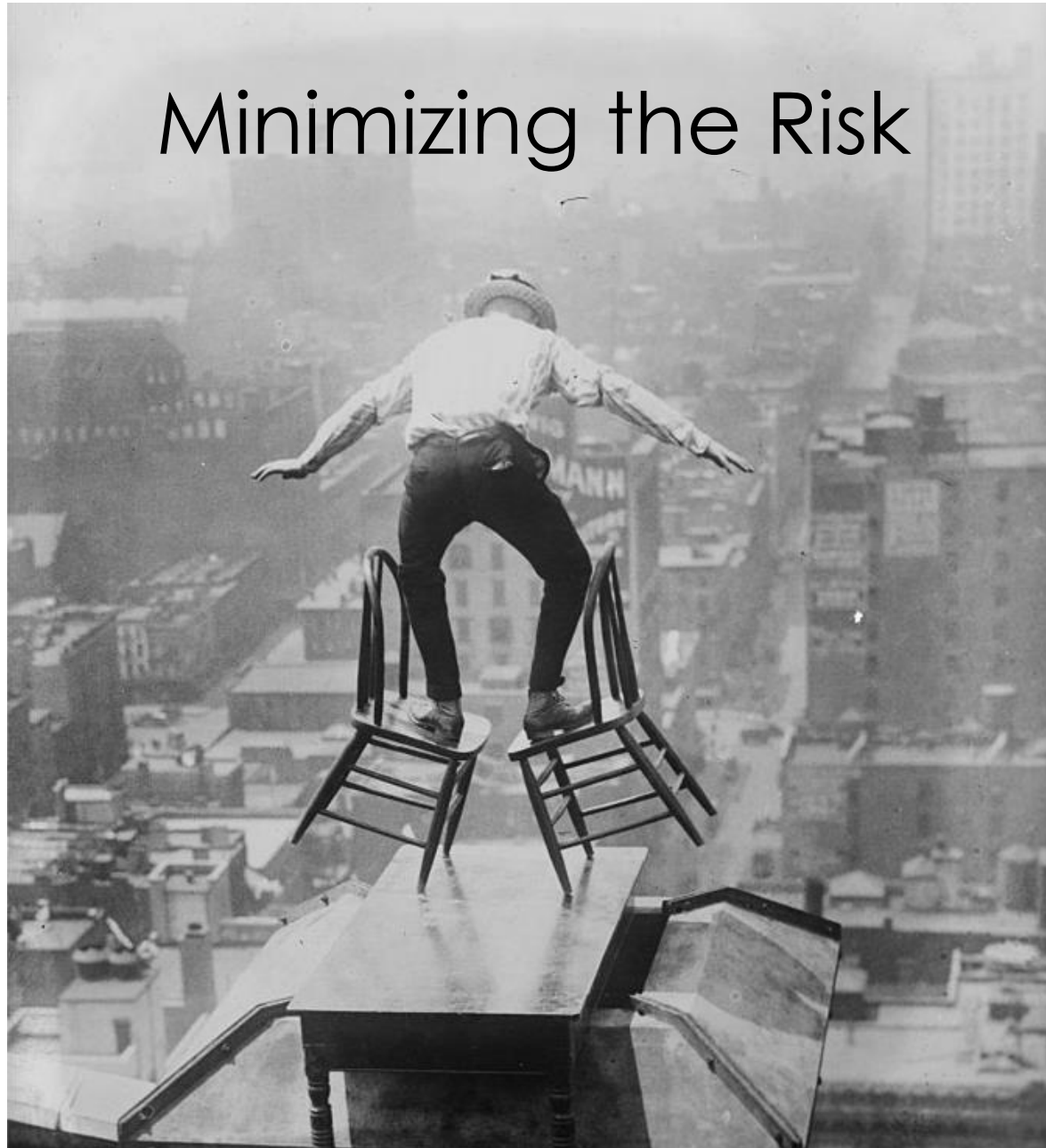
Using Trademarks to Prevent Fraud and Unfair Competition

Preventing domain fraud

- Common element: registering a fraudulent domain identical or confusingly similar to company's trademark
 - Character omitted, added, transposed, or substituted
 - bankoamerica.com
 - chasefinanciel.com
 - Using.co instead of .com
 - www.nike.co



Minimizing the Risk



Minimizing the Risk



- Register obvious variants of domains
- Monitor newly registered domains
- Establish “Culture of Protection” within company with training discussing red flags when using email and accessing external websites
- Implement smarter password management with two-factor authentication

The Playing Field



Minimizing the Risk



Act quickly...

but not precipitously

UDRP Complaint to Cancel and Transfer

- Arbitration proceedings governed by ICANN
- Complainant must prove 3 elements:
 - Fraudulent domain is identical or confusingly similar to trademark
 - Fraudulent domain owner has no rights or legitimate interest in domain
 - Fraudulent domain registered and used in bad faith
- UDRP Complaint “front-loaded”
 - Requisite evidence based upon facts must be alleged and incorporated
 - No entry of default
 - Save evidence while you can



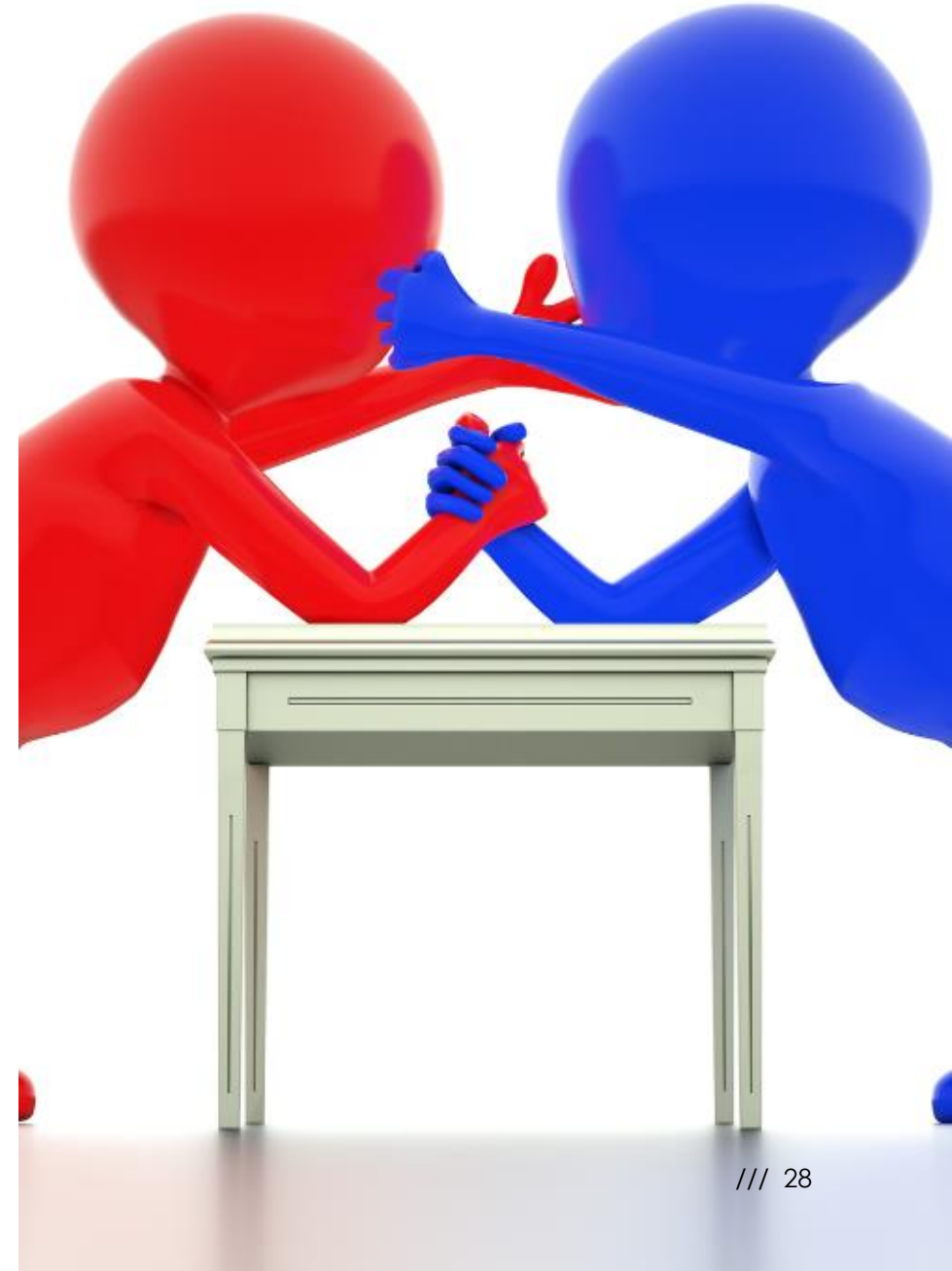
Social Media Handles

- Federally register your trademark
- Secure social media handles
- Monitor social media platforms
- Submit complaint to social media platform



Unfair Competition

- Comparative advertising
- Use on non-OEM replacement parts
- Use in domain names of competitors
- Responses to RFPs



Thank You

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